

## REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed January 7, 2010. At the time of the Final Office Action, Claims 1-3 and 5-58 were pending in this Application. Claims 2, 3 and 41-56 were previously withdrawn due to an election/restriction requirement. Claims 1, 5-40, 57 and 58 were rejected. Claims 1, 10, 17, 20, 29, 35, 37, and 57 have been amended to further define various features of Applicants' invention. Claims 5 and 19 have been cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

### **Rejections under 35 U.S.C. §112**

Claim 37 was rejected by the Examiner under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants amend Claim 37 to overcome these rejections and respectfully request full allowance of the Claims.

### **Rejections under 35 U.S.C. §102**

Claims 1, 4-9, 17-26, 28-30, 33-34 and 57-58 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0163126 by West ("West"). Applicants respectfully traverse and submit the cited art does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that the art cited as anticipatory by the Examiner cannot anticipate the rejected Claims, because the cited art does not show all the elements of the present Claims.

With regard to claim 1 and 29, West does not set forth an active electrode and a return electrode both disposed on a portion of the tissue removal port perimeter. The office action

points out that the shaft **54** as described in West may be an electrode that is on the removal port perimeter and that the leads **64** are not on the port perimeter. Because West does not describe both electrodes being on the port, Applicants submit that West does not set forth every element of claim 1 and 29 as amended, and therefore cannot anticipate amended claims 1 and 29. For at least these reasons, Applicants submit that claims 1 and 29 as amended are in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 4-9, 30, 33, 34, 57 and 58 depend directly or indirectly from claim 1 or 29. Applicants hereby repeat and incorporate the comments made above with regard to amended claims 1 and 29. For at least these reasons, Applicants submit that claims 4-9, 30, 33, 34, 57 and 58 are in condition for allowance, and respectfully request withdrawal of the rejection.

With regard to claim 17, West does not set forth an active electrode and a return electrode both disposed on a portion of the tissue removal port perimeter. The office action points out that the shaft **54** as described in West may be an electrode that is on the removal port and that the leads **64**, while being along the perimeter are not on the perimeter. Additionally, West does not describe a laterally disposed removal port, spaced proximally from the shaft distal end. Because West does not describe both electrodes being on the port, and a laterally placed removal port, Applicants submit that West does not set forth every element of claim 17 as amended, and therefore cannot anticipate amended claim 17. For at least these reasons, Applicants submit that claim 17 as amended is in condition for allowance, and respectfully request withdrawal of the rejection.

Claims 18, 20-26 and claim 28 all depend directly or indirectly from claim 17. Applicants hereby repeat and incorporate the comments made above with regard to amended claim 17. For at least these reasons, Applicants submit that claims 18 and 20-26 and claim 28 are in condition for allowance, and respectfully request withdrawal of the rejection.

### **Rejections under 35 U.S.C. §103**

Claims 10, 12, 15-16, 35-37 and 39 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of U.S. Patent Application Publication No. 2002/0038122 by Peters (“Peters”).

Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claim 10 above, and further in view of U.S. Patent No. 4,203,444 issued to Bonnell et al. (“Bonnell”).

Claims 13 and 40 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent Application Publication No. 2001/0025177 by Woloszko et al. (“Woloszko”).

Claims 14 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over West in view of Peters as applied to claims 10 and 35 respectively above, and further in view of U.S. Patent No. 5,423,844 issued to Miller (“Miller”).

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 17 above, and further in view of Miller.

Claims 31 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over West as applied to claim 29 above, and further in view of U.S. Patent No. 6,032,673 issued to Savage et al. (“Savage”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

When determining whether a claim is obvious, the Examiner must make “a searching comparison of the claimed invention – *including all its limitations* – with the teaching of the prior art.” *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Further, it is well settled that obviousness requires at least a suggestion of all the features in a claim. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Moreover, as the Supreme Court recently stated, “*there must be some articulated reasoning* with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)).

With regard to claim 10, none of the cited references describe both return and active electrode disposed on a second portion of the tissue removal port perimeter. As such, none of the cited references, alone or in combination, at least suggest all of the elements of claim 10 as

amended. As pointed out by the office action, whereas one electrode may be disposed on the perimeter, the references do not describe a configuration where both electrodes are disposed on the perimeter. Therefore, the cited references cannot render obvious claims 10 as amended. For at least these reasons, Applicant respectfully submits that claim 36 is in condition for allowance, and request withdrawal of the rejection.

Claims 12, 15 and 16 all depend either directly or indirectly from claim 10. Applicants hereby repeat and incorporate the comments made above with regard to amended claim 10. For at least these reason, Applicants submit that claims 12, 15, and 16 are in condition for allowance and respectfully request withdrawal of the rejection.

With regard to claim 35, none of the cited references describe a return electrode disposed on the shaft distal end portion and spaced apart, proximally from the port. As such, none of the cited references, alone or in combination, at least suggest all of the elements of amended claim 35 as amended. As pointed out by the office action, the return electrode **54** described by West may be the shaft itself and disposed on the port perimeter, and is not spaced apart, proximally from the port. Therefore, the cited references cannot render obvious claim 35 as amended. For at least these reasons, Applicants respectfully submit that amended claim 35 is in condition for allowance, and request withdrawal of the rejection.

Claims 36, 37 and 39 all depend directly from claim 35. Applicants hereby repeat and incorporate the comments made above with regard to amended claim 35. For at least these reasons, Applicants submit that claims 36, 37, and 39 are in condition for allowance, and respectfully request withdrawal of the rejection.

### **New Claims**

New claims 59 and 60 have been added to further describe the present disclosure.

### **Request for Continued Examination (RCE)**

Applicant encloses a Request for Continued Examination (RCE) Transmittal, and hereby authorized the Commissioner to charge \$810 to Deposit Account No. 50-0359 of ArthroCare Corporation.

### CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

The Commissioner is hereby authorized to charge \$490 for the Two-Month Extension of Time and \$810 for the RCE to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicant believes there are no additional fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.358.5925.

Respectfully submitted  
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